



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,284	01/02/2002	Ralf Ehricht	15111.0066	6813
88859	7590	03/18/2010		
Steptoe & Johnson LLP 1330 Connecticut Avenue, NW Washington DC, DC 20036			EXAMINER FORMAN, BETTY J	
			ART UNIT	PAPER NUMBER
			1634	
			MAIL DATE	DELIVERY MODE
			03/18/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/038,284

Applicant(s)

EHRICHT ET AL.

Examiner

BJ Forman

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 March 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 51-67.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/BJ Forman/
Primary Examiner, Art Unit 1634

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant argues that Andreovski does not teach a chip "sealingly supported by the edged of the recess" as claimed. Applicant asserts that the 5 additional structures used by the reference to provide a "compression fit" is not encompassed by the claim. Applicant asserts that the instant specification at page 14 defines the instantly claimed sealing as via "adhesion, a melt connection or by manufacturing same integrally". Applicant argues that the compression fit for holding as taught by Andreovski is not rigid and therefore is not a chip as claimed.

The arguments have been considered but are not found persuasive. First, the cited passage of the specification does not limit the sealing arrangement as asserted. The passage merely teaches examples of an "unreleasable connection" between the chamber and support. The claims are not limited to an "unreleasable connection". Furthermore, even if the claim defined an unreleasable connection, the passage merely provides examples and therefore cannot limit the invention to the examples discussed. Additionally, the claims are not limited to a "rigid" chip. The claims merely require a chip having immobilized probes and the specification provides no limiting definition for the chip so as to define the claimed chip as rigid. For all the above reasons, the arguments are not commensurate in scope with the claims. The cited passage is reproduced below.

Fig. 2 shows chamber body 1 in a rigid, unreleasable connection with chamber support 5 through its bearing surface 4. This connection, for example, can be realized by adhesion. Alternatively thereto, for example, exists also the possibility of connecting chamber support 5 and chamber body 1 with one another by a melt connection or by manufacturing same integrally. Between chamber support 5 and the clip 2 held by chamber body 1 through the edge 42 thereof, capillary gap 7 (serving as a sample reservoir) is located, which due to its capillary action is capable of taking up liquid sample from sample chamber 3.

Applicant's arguments regarding the membrane of Andreovski have been considered. However, it is maintained that Andreovski teaches the elements required by the claims as detailed in the final office action. The claims require a chamber support (252), a chamber body, sealingly placed on the support and having a recess (211) to support a chip..... and an optically permeable chip (215) supported on the edge of the recess. The permeable chip (215) and chamber support (252) oppose each other to form a PCR chamber (Column 2, lines 30-35). While Andreovski does not teach probes immobilized on the inner surface of the permeable chip (215), Stapleton teaches immobilized probes for PCR and provides the motivation for doing so as discussed in the final office action. It is maintained that the combination of Andreovski and Stapleton teaches all the elements required by the claim.

Applicant argues that the examiner's response in the final office action did not address the relevant question i.e. whether the cited prior art teaches all the elements of the claim and if so, whether one of ordinary skill would have been motivated to combine them. Applicant argues that there is no motivation to omit or substitute the additional structures of Andreovski. The argument has been considered but is not found persuasive. As previously stated, neither the claim nor the specification limit the device so as to exclude the locking rings of Andreovski.

Applicant asserts that there is no structural analogy between the device of Andreovski and the claimed device. Applicant asserts that the references makes no distinction between the upper and lower covers and therefore one of ordinary skill would not have been motivated to modify the device to provide a distinct chamber support, chamber body and chip as claimed. The argument is not found persuasive because it is maintained that Andreovski teaches all the structural elements required by the claims except for the immobilized probes. Stapleton clearly motivates one of ordinary skill to immobilize probes for reaction-chamber PCR.